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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,232	02/22/2005	Werner Gauweiler	266122US0PCT	7199

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT	PAPER NUMBER
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1618

NOTIFICATION DATE	DELIVERY MODE
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02/19/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/525,232	Applicant(s) GAUWEILER ET AL.	
	Examiner JAMES W. ROGERS	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendments to the claims filed 12/30/2008 have been entered. Applicant's amendments to the claims have corrected obvious errors or typos and do not introduce new matter nor do they change the scope of the previously claimed invention.

Response to Arguments

Claims 1-2,8-9 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Maurin et al. (US 6,403,542), for the reasons set forth in the previous office action filed 01/22/2008.

Claims 1-3,6 and 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schade et al. (US 5,962,613) in view of Maurin et al. (US 6,403,542), for the reasons set forth in the previous office action filed 01/22/2008.

Applicant's arguments filed 12/30/2008 have been fully considered but they are not persuasive.

Applicants assert that the polymers of the references above are prepared by conventional methods and use commercially available polymers wherein applicants claimed composition comprises cationic polymers produced by a free-radical water-in-water emulsion polymerization. Applicants assert this limitation is a claim element and cannot be ignored by the examiner. Applicants contend that their examples 1-3 made from water-in-water (W/W) emulsions of monomer mixtures demonstrate improved effects on hair with regards to the combing force when compared to examples 4 and 5 that are produced from solution polymerization of the monomers. Applicants go on to assert that the claimed product by process possesses properties which are not possessed

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by conventional solution polymerized polymers in terms of viscosity and performance in a hair treatment method which is demonstrated in the examples. Applicants assert this demonstration of the effects of the claimed invention meets the burden of proof as to the effects of the product by process limitation, thus applicants surmise any reference cited against their claims must also contain polymers produced in the same manner.

Applicants lastly assert that the sections relied upon by the examiner within Maurin for teaching salts and colloids describes detergents and not a process for W/W emulsion polymerization in which the salt and colloid are present.

The relevance of these assertions is unclear. Applicants claims as currently amended are drawn to a method of cosmetically treating hair, skin or nails by applying an aqueous polymer dispersion, the claims **are not** drawn to a method of producing an aqueous polymer dispersion or a method of producing a polymer. Essentially the limitation within claim 1 that states the cationic polymer is prepared by free radical water-in-water emulsion polymerization is a product by process type of limitation for the composition; however the composition is not even claimed. Since Maurin teaches applying compositions with the same ingredients claimed by applicants for the treatment of hair all of the limitations of the rejected claims above are met. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695,

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698, 227 USPQ 964, 966 (Fed. Cir. 1985). Even though applicants state that the cationic polymers of Maurin are produced from a different method the claims must recite a limitation on treating hair that is not recited or inherent from the teachings of Maurin. For instance applicants have not limited the compositions viscosity, the molecular weight of the polymer or any other property of the composition or the polymers within that composition to exclude the composition and polymers of Maurin. A product by process limitation alone is not sufficient disclosure of a property; it must have a physical and tangible result that is measurable. Applicants claims as currently amended are simply too broad in scope in regards to the composition and polymer to exclude the composition and polymers of Maurin. The relevance of applicant's assertion that examples 1 and 3 produced from water-in-water emulsions have improved structure, high solid content and shampoo properties than examples 4 and 5 produced by solution polymerization is unclear. Firstly applicant's claim 1 does not claim a shampoo which softens hair so that a particular applied force can comb it is not claimed; therefore this argument does not appear to be relevant to the claimed invention. Furthermore it appears as though applicants are arguing unexpected results for their claimed composition in regards to the 102(b) rejection over Maurin, however evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). As described above independent claim 1 does not recite a feature or property for the method of treating the hair that would preclude the combination of Schade and Maurin. Since the

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method of treating hair by applying the composition disclosed by the combination of Schade and Maurin falls within the scope of applicants claimed invention all limitations within the current claim set are considered met. Furthermore it is noted by the examiner that examples 1-5 are very narrow as to the contents of the shampoos, thus their scope is much narrower than what is actually being claimed by applicants and the comparative examples are narrower than the broad disclosures of Schade and Maurin. Regarding applicants assertion that the salts and colloids used in Maurin are drawn to a detergent and not a method to make a polymer, the examiner cited those passages in case 1 f) and g) are ingredients that must be present in the hair composition. It appears from applicants remarks that 1f) and 1g) are merely describing the properties of the polymer (must have a positive charge) in a solution with a salt and a colloid. Thus the examiner will treat 1f) and 1)g as a property of the polymer and such properties would be an inherent feature of any polymer within the scope of applicants claimed invention.

Conclusion

No claims are allowed at this time.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618